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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,257	01/09/2001	Wofgang Gunther	201013US0PCT	8345

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EXAMINER
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TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/720,257

Applicant(s)

GUNTHER ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 11/16/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

This Office action is in response to the amendment filed November 16, 2005 in which claims 1 and 15 were amended.

1. The declaration filed on November 16, 2005 under 37 CFR 1.131 is sufficient to overcome the EP 878532 and Jackson (US 6,348,075) references.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 3, 5-12, 14 and 16-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9, 10 and 12-13 are of copending Application No. 10/505,767. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention are not as broad with respect to the

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propoxylate additive and the amine detergent. Therefore, the species of the present invention anticipate the genus of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 7-10, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 704519 with US 6,579,329 (Thomas) as the English translation.

EP teaches a fuel composition for internal combustion engine comprising a major amount of liquid hydrocarbon fuel and a (i) polyether additive and hydrocarbon polymer. The polyether is based on propylene oxide units wherein n is 8-30 and isotridecanol (see also col. 3, lines 15-25). The additive mixture further includes a (ii) polyisobutylamine detergent additive having a molecular weight of 500-1000 (see col. 2, lines 51-54 and Examples). The ratio of (i) and hydrocarbon polymer and (ii) is 5:95 to 85:15, preferably 20:80 to 80:20 (see col. 3, lines 54-56). The individual proportion of (i) and (ii) is 10-5000 ppm fuel (see col. 4, lines 12-15). The additive is used as an intake

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valve cleaner additive for fuel composition in internal combustion engine (see col. 4, lines 36-41).

Accordingly, EP '519 teaching all the limitations of the claims anticipates the claims.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 704519.

EP has been discussed above. EP fails to teach the claimed ratio of polyoxypropylene ether to polyamine. However, it would have been obvious to one of ordinary skill in the art to have optimized the components given that EP teaches in Examples 4 and 6 a 2:1 and 3:1 ratio of polyamine to isotridecanol reacted with 22 mol of butylenes oxide.

***Response to Arguments***

8. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the claimed propoxylate additive of Formula I has superior properties to propoxylates of shorter or longer chains. Applicant bases this argument on the data presented in Table 1 and 2 of the present specification and the 132 declaration.

Applicant's data have been reviewed and is not deemed to constitute unexpected results. The data of Table 1 show that the C<sub>13</sub> alkyl having 15 propylene oxide units is a better intake valve deposit reducer than the C<sub>13</sub> having 10 or 20 propylene oxide units. However, claims 1, 3, 10 and 14 are not limited to the C<sub>13</sub> alkyl propylene oxide. The examiner cannot ascertain from the data that the same results would be obtained with branched chain alkyl groups as disclosed in EP 704519. Also, the examiner cannot ascertain if the same results would be obtained with compounds with 14 and 16-18 units of propylene oxide as was obtained with 15 units. The declaration is not commensurate in scope with the claims because each example contains a PIB amine of a molecular weight of about 1000. Claims 1, 10 and 14 do not require such a compound. It cannot be ascertained if the presence of the amine is affecting the results.

Applicant argues that in order to anticipate the claims, the prior art must expressly or implicitly describe every limitation of the claimed invention. Applicant argues that none of the prior art references describe a propoxylate additive having 14-18 propylene oxide units and a single end-group that is a C<sub>8</sub>-C<sub>18</sub> alkyl or alkenyl group.

It is well settled that a generic formula will anticipate a claimed species covered by the formula when the species can be "at once envisaged" from the formula.

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Furthermore, prior art that teaches a range within overlapping or touching the claimed range anticipates if the prior art range discloses the claimed range with "sufficient specificity." In the instant case, the prior art meets these limitations. See MPEP 2131.02 and 2131.03.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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